

Notice of Allowability

Application No.

10/810,859

Examiner

JOHN PAK

Applicant(s)

BESSETTE ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to _____.
2. ☒ The allowed claim(s) is/are 2-11, 13-15 and 19-21 [renumbered as 1-16].
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

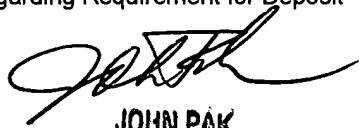
Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 3/29/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.


JOHN PAK
PRIMARY EXAMINER
GROUP 1600

After the entry of the preliminary amendment of 3/29/2004, claims **2-21** are pending in this application.

Restriction Requirement

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 3-11, 13-15, drawn to method of killing or controlling ants, fleas, earwigs, ticks, beetles, flies, crickets, cockroaches, wasps, mosquitoes, pillbugs and spiders, classified in class 514, subclasses 546 and 730.
- II. Claim 12, drawn to method of killing or controlling termites, classified in class 424, dig. 11, and class 514, subclasses 546 and 730.

Claims 2 and 16-21 link inventions I and II. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claims 2 and 16-21. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104. Claims that require all the limitations of an allowable linking claim will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim(s) including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Distinctness of the inventions is due to the fact that control of various different insects is not entirely predictable in this art. Controlling or killing termites is a specialized art, and use of generally non-toxic ingredients such as benzyl alcohol and phenethyl propionate for termites would certainly be considered separate subject for inventive effort by the person of ordinary skill in this art.

Even though the two inventions share similar classification search areas, the totality of the search required here, including commercial database search, would be divergent and undue for both inventions due to the breadth of prior art related to insect control and claimed ingredients. Each of the invention would require separate searching for treatment of the different insects and separate patentability determinations. Under the facts present in this application, the search and examination burden for more than one invention group would be undue.

Therefore, the restriction requirement as set forth above is deemed to be proper.

During telephone conversations with Mr. Gadiano on 3/27/2006 and 3/31/2006, an election was made without traverse to prosecute the invention of Group I, claims 3-11 and 13-15 .

Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in telephone interviews with Mr. Gadiano on 3/31/2006 and 4/3/2006.

Amendment to the Claims

Cancel claims 12 and 16-18.

Claim 2. (Currently amended) A method for killing or controlling invertebrates comprising:

applying a pesticidally-effective amount of a pesticidal composition to invertebrates or to a locus where killing or control of invertebrates is desired, wherein (i) the invertebrates are selected from the group consisting of ants, cockroaches, spiders, fleas, ticks, earwigs, pillbugs, beetles, flies, crickets, mosquitoes, and wasps, and (ii) the pesticidal composition is unscented and comprises an inert carrier and a pesticidally active ingredient consisting of benzyl alcohol and phenethyl propionate.

Claim 3. (Currently amended) The method of claim 2, wherein the invertebrates are ants.

Claim 4. (Currently amended) The method of claim 2, wherein the invertebrates are fleas.

Claim 5. (Currently amended) The method of claim 2, wherein the invertebrates are earwigs.

Claim 6. (Currently amended) The method of claim 2, wherein the invertebrates are ticks.

Claim 7. (Currently amended) The method of claim 2, wherein the invertebrates are beetles.

Claim 8. (Currently amended) The method of claim 2, wherein the invertebrates are flies.

Claim 9. (Currently amended) The method of claim 2, wherein the invertebrates are crickets.

Claim 10. (Currently amended) The method of claim 2, wherein the invertebrates are cockroaches.

Claim 11. (Currently amended) The method of claim 2, wherein the invertebrates are wasps.

Claim 13. (Currently amended) The method of claim 2, wherein the invertebrates are mosquitoes.

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Claim 14. (Currently amended) The method of claim 2, wherein the invertebrates are pillbugs.

Claim 15. (Currently amended) The method of claim 2, wherein the invertebrates are spiders.

Claim 21. (Currently amended) The method of claim 2, wherein the carrier is a member selected from the group consisting of: a wettable powder, a dry powder, a dust, an aerosol propellant, and water having at least one emulsifier therein.

Amendment to the Specification

Amend the paragraph beginning at page 1, line 5 (see applicant's preliminary amendment of 3/29/2004) as follows: after "09/578,724, filed May 26, 2000," insert --- now U.S. Patent No. 6,713,518, --- .

Amendment to the Abstract

Delete the text of the abstract in its entirety, and insert therefor the following new abstract -----

Disclosed is a method for killing or controlling invertebrates comprising applying a pesticidally-effective amount of a pesticidal composition to invertebrates or to a locus where killing or control of invertebrates is desired, wherein (i) the invertebrates are selected from the group consisting of ants, cockroaches, spiders, fleas, ticks, earwigs,

pillbugs, beetles, flies, crickets, mosquitoes, and wasps, and (ii) the pesticidal composition is unscented and comprises an inert carrier and a pesticidally active ingredient consisting of benzyl alcohol and phenethyl propionate.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance: At the outset, the following is noted with respect to claim interpretation.

"the active ingredient"

The claim language "the active ingredient" in the dependent claims is construed to mean the mixture of benzyl alcohol and phenethyl propionate.

"unscented"

The Examiner is mindful that claims must be interpreted as broadly as their terms reasonably allow during prosecution.

Applicant does not provide a specialized definition in the originally filed disclosure for "unscented." Webster's unabridged dictionary defines "unscented" as "deprived of scent: having no scent < an ~ soap." However, it must be noted that even an unscented soap has some odor due to the inherent characteristics of basic soap ingredients, so "unscented" cannot equate to total absence of any odor or scent.

The context of terms surrounding "unscented" in independent claim 2 shows the unscented composition to contain benzyl alcohol and phenethyl propionate. Both of

these ingredients carry some scent. In fact, phenethyl propionate is an ester, so it is a fragrant material. Further, applicant's specification discloses on page 33, Example 4 an "unscented" pesticidal composition containing benzyl alcohol, phenethyl propionate, tetrahydrofurfuryl alcohol¹, isopropyl alcohol, Isopar M , and an aerosol propellant. Therefore, the plain meaning of "unscented" as understood by one having ordinary skill in the art is not having an added scent ingredient, i.e. an additional fragrance or perfume ingredient. This plain meaning is consistent with the dictionary meaning, as it applies to an "unscented soap," which has the scent of its basic ingredients but does not contain an additional fragrance or perfume ingredient.

In sum, "unscented" is construed to mean not having an additional fragrance or perfume ingredient.

Turning now to the substance of the claimed subject matter, it is noted that the claimed invention is directed to killing or controlling specific invertebrates by applying an unscented composition comprising an inert carrier + a pesticidally active ingredient consisting of benzyl alcohol and phenethyl propionate.

The state of the art is in a state of some uncertainty or inconsistency as to how such a composition would perform. **HCAPLUS abstract 1983:174818** discloses benzyl alcohol to be "unsatisfactory" against eggs and larvae of mosquitoes. **CABA abstract**

¹ The Tetrahydrofurfuryl (THFA) alcohol printout from the National Organic Standards Board Technical Advisory Panel Review is cited on the attached PTO-892 and noted for the record herein –

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2002:16356 discloses benzyl alcohol to have repellent activity to wasps. **HCAPLUS abstract 1992:464791** discloses benzyl alcohol to be attractive to ticks without disclosing or suggesting any toxicity. **CABA abstract 82:24729** discloses phenethyl propionate to be attractive to Japanese beetles without disclosing or suggesting toxicity of phenethyl propionate to said beetles. **HCAPLUS abstract 2000:777822** is typical of inventive efforts in this field in using phenethyl propionate as an attractant in combination with a known insecticide.

Based on the prior art available to the ordinary skilled artisan at the time the invention was made, he/she would not have been able to reasonably expect “pesticidally-effective” controlling or killing of ants, cockroaches, spiders, fleas, ticks, earwigs, pillbugs, beetles, flies, crickets, mosquitoes, and/or wasps. Neither benzyl alcohol nor phenethyl propionate were taught to be particularly effective against those invertebrates in an unscented composition, and the effect of mixing the two ingredients against said invertebrates could not have been predicted given the myriad ineffective or unknown pesticidal or pest controlling activity and attractancy-repellency of the ingredients to the different invertebrates claimed here.

Against this backdrop, applicant provides clarity of consistent pesticidal results. In the specification, at pages 33-66, applicant establishes consistently high pesticidal

experimental results against all the invertebrates recited in the claims of this application, as presently amended. Such results, viewed in consideration of the claimed invention *as a whole*, establish the nonobviousness of the claimed invention.

Further, prosecution history of the parent application to this application and another related application warrants a mention here. In the direct parent application, 09/578,724, now U.S. Patent No. 6,713,518, a restriction requirement was made between the composition invention and the method invention (Office action of 10/29/2002 in that application). In a related application, 09/362,189, now U.S. Patent No. 6,849,614, a restriction requirement was also made between the composition and the method invention (Office action of 9/28/2000 in that application). It is noted that the present invention is directed to methods only.

U.S. Patent No. 6,531,163 (not prior art) is noted, but the claims there are directed to the use of a scented composition because the composition there requires peppermint oil. The Examiner has considered the issue of obviousness type double patenting with respect to this patent but has determined that a rejection under that ground would not be proper. The instant invention uses an unscented composition, which would exclude peppermint oil, whereas the invention of the 6,531,163 patent requires the use of peppermint oil. Moreover, given the previous discussion of prior art understanding of benzyl alcohol and phenethyl propionate, there would have been insufficient motivation to exclude peppermint oil when it was required in said patented

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invention to provide pesticidally-effective results; and furthermore, one having ordinary skill in the art would not have reasonably expected the high pesticidal results established by applicant in the instant specification without the use of peppermint oil.

For these reasons, the claimed invention, as a *whole*, is deemed to be allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Sreeni Padmanabhan, can be reached on **(571)272-0629**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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